

## **REMARKS**

### **I. STATUS OF CLAIMS**

Claims 1-5, 7-9, 11 and 23-24 are currently pending in this application. Claims 12-22 were previously withdrawn. The Action states that claims 1-5, 7-9 and 23-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 6,172,591 to Barrett ("Barrett"). As noted, however, in the Interview Summary regarding the interview of September 24, 2003, between Examiner Easthom and Applicant's counsel, the Barrett reference cannot be asserted as a § 102(b) reference because it issued (and was thus "patented or described in a printed publication") after the effective filing date for the present application. The statutory basis for the Examiner's rejection of claims 1-5, 7-9 and 23-24 was thus changed to 35 U.S.C. § 102(e). Claims 23-24 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by publication WO98/12715 to Kojima ("Kojima"). Finally, claim 11 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Barrett in view of United States Patent No. 5,831,510 to Zhang et al. ("Zhang").

### **II. RESERVATION OF RIGHTS REGARDING CLAIMS 12-22**

The Action states that claims 12-22 are withdrawn from consideration. Claims 12-22 were previously withdrawn in response to the restriction requirement of September 15, 2000. Applicant hereby cancels claims 12-22, thus obviating the withdrawal. By canceling claims 12-22, Applicant does not admit the propriety of the restriction requirement and hereby reserves the right to pursue those claims, as well as the subject matter claimed therein, in a related or other patent application.

**III. IN VIEW OF THE ENCLOSED RULE 131 DECLARATION,  
BARRETT IS NOT PRIOR ART UNDER 35 U.S.C. § 102(e)**

As stated above, the Examiner applies Barrett under 35 U.S.C. § 102(e) to reject Applicant's claims 1-5, 7-9 and 23-24. A § 102(e) rejection, however, may be overcome by antedating the filing date of the reference by submitting a declaration pursuant to 37 C.F.R. 1.131. *See* MPEP § 2136.05 (8<sup>th</sup> ed., 1<sup>st</sup> rev. Feb. 2003). The application that issued as Barrett was filed on March 5, 1998.

In order to antedate or "swear behind" the Barrett reference, Applicant encloses the "Declaration of Honorio S. Luciano pursuant to 37 C.F.R. § 1.131" (hereafter the "Luciano Declaration") to establish that prior to March 5, 1998, Mr. Luciano conceived of the present invention embodied in pending claims 1-5, 7-9, and 23- 24 (Luciano Declaration, ¶¶ 2-4). Further, from a time of conception prior to March 5, 1998, and continuing until after July 28, 1998, which is the filing date of the provisional patent application to which the present application claims priority, Mr. Luciano diligently and continuously reduced the invention to practice (*id.* at ¶ 5). Accordingly, Applicant submits that Barrett does not qualify as prior art under 35 U.S.C. § 102(e) to the present invention of claims 1-5, 7-9 and 23-24, and respectfully requests that the rejection be withdrawn and the same claims allowed to issue.

**IV. BECAUSE KOJIMA DID NOT PUBLISH MORE THAN ONE YEAR  
PRIOR TO THE EFFECTIVE FILING DATE OF THE PRESENT  
APPLICATION, KOJIMA IS NOT PRIOR ART UNDER 35 U.S.C. § 102(b)**

The Action states that claims 23-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kojima. The Kojima reference was published on March 26, 1998. The present application has an effective filing date of July 28, 1998, which is when provisional application Serial No. 60/094,434, to which the present application claims priority, was filed. Thus, because Kojima was not published more than one year prior to the earliest effective filing date for Applicant's claimed invention, Kojima cannot serve as a basis to reject Applicant's claims under

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35 U.S.C. § 102(b). Applicant respectfully requests that the rejection of claims 23-24 be withdrawn, and the same claims allowed to issue.

**V. BECAUSE BARRETT IS NOT AVAILABLE PRIOR ART UNDER 35 U.S.C. § 102, IT CANNOT SERVE AS A PREDICATE FOR A § 103(a) REJECTION**

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Barrett in view of Zhang. However, as shown above, and as detailed in the enclosed Luciano Declaration, Applicant's invention antedates the Barrett reference. Applicant respectfully submits that the § 103(a) rejection of claim 11 is thus obviated (*see* MPEP § 2141.01), and requests that the rejection be withdrawn and the same claim allowed to issue.

Respectfully submitted,

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**CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on December 5, 2003.

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